

REMARKS

Upon entry of the present amendment, claims 1-9 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the claims do not incorporate new matter into the application as originally filed. For example, claim 3 finds support at page 7 of the application, line 21, new claim 5 finds support at page 7, line 20, and claims 6-9 find support at page 6, lines 21-23.

Entry of the present amendment is thus respectfully requested.

***Claim Rejections Under 35 USC § 103(a)***

Claims 1, 3 and 4 have been rejected under 35 USC § 103(a) as being unpatentable over Tao et al. (WO 99/60973). Further, claim 2 has been rejected under 35 USC § 103(a) as being unpatentable over Tao et al. as applied to claim 1, further in view of Morman et al. (US 5,883,028). Reconsideration and withdrawal of each of these rejections is requested based upon the following considerations.

***The Present Invention and Its Advantages***

The present invention provides absorbent articles having a breathable backsheet which is printed in multicolor and has a

cloth-like appearance and feel. Backsheets for the articles are also provided and separately claimed.

The present invention provides for a multicolored-printed absorbent article which is satisfactory in both clearness of the printing itself and texture or touch, and also provides a backsheet for the absorbent article.

In particular, the present invention has been accomplished by the discovery that an absorbent article comprising a liquid-permeable topsheet, a liquid-impermeable backsheet, and a liquid retentive absorbent member interposed between the topsheet and the backsheet, wherein the backsheet comprises a laminated sheet composed of a breathable or water vapor permeable film printed with a multi-colored pattern and a nonwoven material, which nonwoven material is supported on the printed side of the breathable film, can still provide a printed area which is satisfactory in both clearness of the printing and texture or touch, when the printed side of the film possesses an  $L^*$  value of from 10 to 93 and a  $C^*$  value of from 20 to 120 as measured with a color difference meter, and wherein the nonwoven material has a light transmittance of 40 to 83%.

Apart from the above description, the Examiner is invited to review Applicants' specification, especially page 5, line 25 to page 8, line 1, and Examples 1 and 2 and Comparative Examples 1 and 2 (and Table 1) at pages 10-13 of the application. Upon review of

these portions of the application, it can clearly be seen that the absorbent articles of the present invention, which contain therein printed areas of a breathable film having  $L^*$  and  $C^*$  values falling within those instantly claimed, and utilizing nonwoven material having a light transmittance within the specified range, are able to satisfy both requirements of print visibility and a good texture and feel to the touch, wherein comparative absorbent articles were not able to produce such results.

Distinctions Over the Cited Art

The primary cited reference of Tao et al. (WO 99/60973) is clearly discussed in the background section of the present application at page 1, lines 22-28. In this respect, the "b" value provided therein simply relates to a value relating to the "yellowing" or "yellowish" color of a film. (See Tao et al., page 4, line 31 to page 5, line 17.) As such, the "b" value described and taught in Tao et al. is completely different from the present invention's use of " $L^*$ " and " $C^*$ " values as multicolor printing parameters, in order to provide an absorbent article, or backsheet, that is satisfactory in both clearness of the printing and texture or touch. As acknowledged by the Examiner in the Office Action, Tao et al. is completely silent as to the utilization of " $L^*$ " and " $C^*$ " values for the printed area of an absorbent article. Further, as also acknowledged by the Examiner, Tao et al. does not disclose

the light transmittance of a nonwoven material, such as is recited in the present invention. Based on this lack of teachings in the cited Tao et al. reference, it is submitted that the same cannot properly serve as a primary basis for rejecting Applicants' claims under 35 USC § 103(a).

Even so, the Examiner contends that the Tao et al. disclosure of a "b" value in combination with Tao's use of a bright color, such as royal blue (see page 6, line 24) serves as a proper basis for rejecting the Applicants' claims. However, this is incorrect, since the reference completely fails to disclose or otherwise teach all of the recited parameters of the instant claims, including specified values for "L\*" and "C\*" values of color. The simple use of a royal blue color does not arrive at the instant invention as evidenced by the fact that both Examples and Comparative Examples in the specification use blue colored areas (see Table 1).

The Examiner has also utilized a secondary reference of Morman (US 5,883,028) in an attempt to cure the deficiencies of the cited primary reference of Tao et al. However, the cited secondary reference of Morman does not alleviate or lessen the deficiencies of the primary reference of Tao et al., since the secondary reference at best only discloses the basis weights for certain nonwoven materials utilized therein. This disclosure does not render obvious the claimed invention, since the major deficiencies

of Tao et al. noted above have not been corrected by the secondary reference's disclosure.

The Examiner's citation of Tao et al. and Morman against Applicants' claims, appears to result from the Examiner's reliance upon an "obviousness to try" standard for determining patentability, instead of providing evidence that one of ordinary skill in the art, upon reviewing the references' disclosures, would be motivated to arrive at the invention as instantly claimed. As such, it is submitted that the Examiner's rejection is faulty and cannot be sustained.

In this respect, the Examiner is also reminded that simply asserting that many things are "well-known in the art" (e.g., see page 2 of the Office Action) does not alleviate the Examiner's duty to produce evidence that one of ordinary skill in the art would be motivated to arrive at the instant invention being claimed.

For the Examiner's consideration, the following excerpts from three (3) separate decisions of the Court of Appeals for the Federal Circuit are provided. It is believed that upon a full consideration of these excerpts, and the comments presented above, that the Examiner will find that the present claims 1-9 are fully allowable and patentable over each of the references cited, whether considered singularly or in combination.

As stated by the Court of Appeals for the Federal Circuit in the case of *In re Lee*, 61 USPQ2d 1430 (2002):

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

As stated by the Court of Appeals for the Federal Circuit in the case of *In re Kotzab*, 55 USPQ2d 1313 (2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior

art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.*

As stated by the Court of Appeals for the Federal Circuit in the case of *In re Dembiczak*, 50 USPQ2d 1614 (1999):

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. Section 103(a) (Supp. 1998); see *Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ



459, 465 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. See *Graham*, 383 U.S. at 17-18, 148 USPQ at 467; *Miles Labs, Inc., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). ...

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," see *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have

been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not

*sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).*

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance, clearly indicating that each of Applicants' pending claims are allowed and patentable under the provisions of Title 35 of the United States Code.

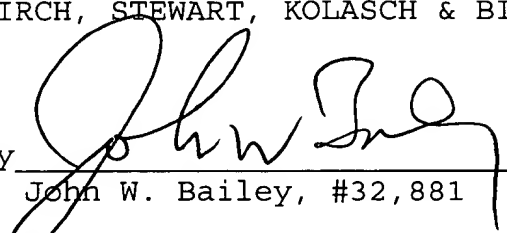
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims have been amended as follows:

3. (Amended) The absorbent article according to claim 1, wherein said nonwoven material has a [thickness of 0.5 to 3.0 mm before laminating] basis weight of 30 to 45 g/m<sup>2</sup>.

Claims 5-9 have been added.